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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,944

05/05/2006

Roger Milliken

9230

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25280

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06/24/2008

Legal Department (M-495)  
P.O. Box 1926  
Spartanburg, SC 29304

EXAMINER

JUSKA, CHERYL ANN

ART UNIT

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1794

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



<b>Office Action Summary</b>	<b>Application No.</b> 10/541,944	<b>Applicant(s)</b> MILLIKEN ET AL.	
	<b>Examiner</b> Cheryl Juska	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 16 is/are rejected.
- 7) ☒ Claim(s) 5-15 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/05, 04/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 5-15 and 17 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim (e.g., claims 4, 13, or 15). See MPEP § 608.01(n). Accordingly, the claims 5-15 and 17 have not been further treated on the merits.

### ***Specification***

2. The disclosure is objected to because of the following informalities: The lack of subheadings according to 37 CFR 1.77(b). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102/103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person



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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 16 is rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 2004/0253370 issued to Hoersch.

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Hoersch is drawn to a synthetic suede leather and a process for making the same (title). Said leather is made by applying a foamed polyurethane dispersion on a textile substrate composed of a yarn and subsequently coagulating said dispersion (abstract).

Thus, Hoersch teaches the limitations of claim 16 with the exception of the recited specimen breakdown property and the air permeability. Although Hoersch does not explicitly teach these property limitations, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e., textile substrate with coagulated polyurethane dispersion thereon) and in the similar production steps (i.e., applying polyurethane foam to textile, coagulating, drying, and condensation of said polyurethane) used to produce the synthetic suede leather. The burden is upon applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 495. In the alternative, the claimed specimen breakdown property and air permeability would obviously have been provided by the process disclosed by



Hoersch. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

6. Claim 16 is rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 6,599,849 issued to Vogt et al.

Vogt discloses an artificial leather made by a process of applying a foamed elastomer composition onto a knitted textile and coagulating said foamed composition (abstract). The elastomer composition may be a polyurethane dispersion (col. 3, lines 14-22).

Thus, Vogt teaches the limitations of claim 16 with the exception of the recited specimen breakdown property and the air permeability. Although Vogt does not explicitly teach these property limitations, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e., textile substrate with coagulated polyurethane dispersion thereon) and in the similar production steps (i.e., applying polyurethane foam to textile, coagulating, and drying) used to produce the synthetic suede leather. The burden is upon applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 495. In the alternative, the claimed specimen breakdown property and air permeability would obviously have been provided by the process disclosed by Vogt. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

#### ***Claim Rejections - 35 USC § 103***

7. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Hoersch reference alone.



The Hoersch reference also discloses the features of present claim 1 with the exception that the textile substrate is printed. See, for example, claim 1 of Hoersch. However, claim 1 is rejected as obvious over the Hoersch reference since it has been held that the addition of printed matter to existing product will not distinguish invention from prior art in terms of patentability if printed matter is not functionally related to product. *In re Ngai*, 70 USPQ2d 1862. There is nothing on record establishing the printed matter of claim 1 as being functionally related to the synthetic suede. It appears said printed matter is merely a matter of ornamentation. Also, note it has been held that matters relating to ornamentation only which have no mechanical function cannot serve to patentably distinguish the claimed invention from the prior art. *In re Seid*, 73 USPQ 431. Hence, claim 1 is rejected as being obvious over the prior art.

Claims 2-4 are also rejected since Hoersch clearly teaches these features. see at least claims 3-5 of the reference. [While claims 5-7, 11-15, and 17 are not officially being examined on the merits due to the improper multiple dependency status of said claim, note Hoersch teaches the limitations of these claims in at least claims 6, 7, and 11-17.]

8. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited US Vogt reference alone.

As noted above, Vogt discloses an artificial leather made by a process of applying a foamed elastomer composition onto a knitted textile and coagulating said foamed composition (abstract). The elastomer composition of Vogt includes a polymer dispersion (i.e., polyurethane), an acid-generating chemical, and a foam-stabilizing surfactant (i.e., foaming agent) (abstract, col. 3, lines 38-53 and col. 3, line 66-col. 4, line 10). The elastomer composition may also include cross-linking agents for condensation or curing of the elastomer



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(col. 5, line 66-col. 6, line 1). Note the textile substrate may also be treated with dyes, colorants, or pigments (col. 5, lines 61-62).

Hence, Vogt discloses the features of claims 1-4 with the exception that the textile substrate is printed. Yet, said claims are rejected as obvious over the Vogt reference since it has been held that the addition of printed matter to existing product will not distinguish invention from prior art in terms of patentability if printed matter is not functionally related to product. *In re Ngai*, 70 USPQ2d 1862. There is nothing on record establishing the printed matter of claim 1 as being functionally related to the synthetic suede. It appears said printed matter is merely a matter of ornamentation. Also, note it has been held that matters relating to ornamentation only which have no mechanical function cannot serve to patentably distinguish the claimed invention from the prior art. *In re Seid*, 73 USPQ 431. Hence, claims 1-4 are rejected as being obvious over the prior art.

9. In the alternative, claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Hoersch reference in view of EP 904 950 assigned to Kuraray Co., Ltd.

In the alternative, claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Vogt reference in view of EP 904 950 assigned to Kuraray Co., Ltd.

As opposed to the rejection of claims 1-4 over the Hoersch and Vogt references alone, the claims are alternately rejected over said references in view of the Kuraray reference.

Specifically, printed synthetic leathers are well known in the art. For example, Kuraray discloses a synthetic leather having an ink-jet printed image thereon (abstract). Hence, it would have been readily obvious to one skilled in the art to print the synthetic suede leather of Hoersch or Vogt



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since said printing would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Therefore, claims 1-4 are rejected over the prior art.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-5 of copending Application No. 10/482,577. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to employ a printed textile substrate.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



***Conclusion***

12. The art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached at 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Cheryl Juska/*  
Primary Examiner  
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